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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,475	08/24/2004	Guido Mayer	3165-105	1724

6449 7590 11/29/2007
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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11/29/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/505,475

Applicant(s)

MAYER ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-31 is/are rejected.
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- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
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Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Final Rejection

The Status of Claims:

Claims 6, and 8-31 are pending.

Claims 6 and 8-31 have been rejected..

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 6, 17-18, 21, and 28-31 under 35 U.S.C. 102(b) as being anticipated clearly by Oberdorf et al (US 6,114,342) has been withdrawn due to applicants' convincing argument.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 6, and 8-31 under 35 U.S.C. 102(b) as being anticipated clearly by Oberdorf et al (US 6,114,342) in view of Jemty et al (J. Org. Chem . 1981, 46. 4545-4551) and Moody et al (Synlett 1999, no. 10, 1575-76).

The rejection of Claims 6, and 8-31 under 35 U.S.C. 102(b) as being anticipated clearly by Oberdorf et al (US 6,114,342) in view of Jemty et al (J. Org. Chem . 1981, 46. 4545-4551) and Moody et al (Synlett 1999, no. 10, 1575-76) has been maintained with the reasons of record on 7/10/07.

Applicants' Arguments

Applicants argue in the followings:

1. the Jemty prior art discloses that the silica supported iron chloride is used in a 1.1 molar ration ,whereas the claimed catalyst uses an amount of from 0.001 to 0.5 mol equivalents;
2. the present claims do not require the ether cleaving event to be dependent first upon nitro group reduction because a nitro group is not included in the claimed starting compounds unlike the prior process;

3. Moody discloses that " benzyl ethers remained intact, demonstrating the selectivity of the reaction, " unlike the claimed invention which requires a benzyl ether to be cleaved; thus, it is not applicable to the current invention.

Applicants' arguments have been noted, but the arguments are not persuasive.

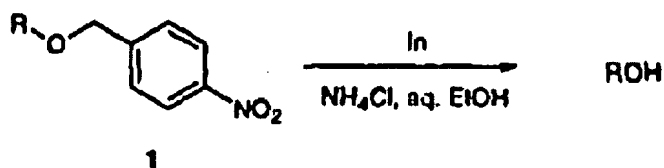
First, regarding the first argument , the Examiner has noted applicants' arguments. However, the difference about the usage of the amount of the catalyst does not carry much of the patentable weight over the prior art since the limitation of a process with respect to ranges of pH, time ,temperature, speed ,and amount does not impart patentability to a process when such values are those which would be determined by one of ordinary skill in the art in achieving optimum operation of the process. The catalytic amount in the process is well understood by those of ordinary skill in the art to be a result-effective variable, especially when attempting to control selectivity and the operational cost of the process. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to adjust the amount of the catalyst in the Jempty prior art by routine experimentation in order to optimize the reaction process . Therefore, applicants 'argument is not persuasive.

Second, regarding the second argument , the Examiner has noted applicants' arguments. However, on the contrary to applicants 'arguments, the claimed starting compounds do have the nitro group present in claimed compounds (II) of claim 1 in

which one of the variable R is nitro ; therefore, there is no difference between the starting prior art compounds and the claimed compound ones . Therefore, applicants' argument is not persuasive.

Third, regarding the third argument , the Examiner has noted applicants' arguments. However, Moody et al expressly discloses that the use of indium in aqueous ethanolic ammonium chloride is an effective method for deprotection of 4 – nitrobenzyl ethers and esters (see page 1575, table 1 and following paragraph) as shown below:

Table 1 Deprotection of 4-nitrobenzyl ethers and esters



<i>I</i>	<i>R</i>	<i>Yield / %</i>
a	PhCH ₂ CH ₂	87
b	PhOCH ₂ CH ₂	98
c	PhCH ₂ OCH ₂ CH ₂	100
d	(1 <i>R</i> ,2 <i>S</i> ,5 <i>R</i>)-2-isopropyl-5-methylcyclohexyl	93
e	4-MeO-C ₆ H ₄	81
f	4-Ac-C ₆ H ₄	97
g	3-OHC-C ₆ H ₄	61
h	2,3,5-Me ₃ -C ₆ H ₂	100
i	2,4,5-Cl ₃ -C ₆ H ₂	90
j	6-quinoliny	97
k	4-Cl-C ₆ H ₄ -CO	90
l	(±)-CbzNHCHMeCO	96

All substrates were cleaved in good yield, and benzyl carbamates and benzyl ethers remained intact, demonstrating the selectivity of the reaction. Other functional groups

From the above table and these passages, it becomes clear that the Moody has tried to show that the cleavage of the benzylic C-O bond in the main portion of 4-nitrobenzyl ether compound does take place without cleaving its side chain group (R) which contains benzyl ethers groups. Thus, the prior art still reads on the claimed invention. Therefore, applicants' argument is not persuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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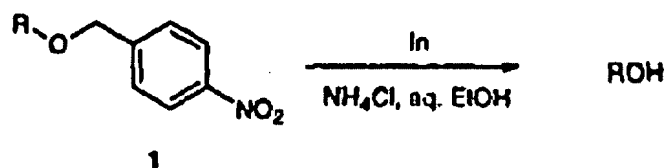
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Application/Control Number:
10/505,475
Art Unit: 1625

Page 7

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TAYLOR VICTOR OH
PRIMARY EXAMINER

11/25/17



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Bib Data Sheet

CONFIRMATION NO. 1724

SERIAL NUMBER 10/505,475	FILING OR 371(c) DATE 08/24/2004 RULE	CLASS 560	GROUP ART UNIT 1625	ATTORNEY DOCKET NO. 3165-105	
APPLICANTS Gueldo Mayer, Gonnheim, GERMANY; Oliver Cullmann, Heppenheim, GERMANY; Bernd Wolf, Fussgonheim, GERMANY; Michael Keil, Freinsheim, GERMANY;					
CONTINUING DATA ***** This application is a 371 of PCT/EP03/01160 02/06/2003					
FOREIGN APPLICATIONS ***** GERMANY 102 08 029.1 02/26/2002					
IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** 03/01/2005					
Foreign Priority claimed <input checked="" type="checkbox"/> yes <input type="checkbox"/> no 35 USC 119 (a-d) conditions <input type="checkbox"/> yes <input type="checkbox"/> no <input type="checkbox"/> Met after met Verified and Acknowledged <i>[Signature]</i> Examiner's Signature Initials		STATE OR COUNTRY GERMANY	SHEETS DRAWING 0	TOTAL CLAIMS 26	INDEPENDENT CLAIMS 1
ADDRESS 6449					
TITLE Method for producing 2-chloromethylphenyl acetic acid derivatives					
FILING FEE RECEIVED 1028	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit		